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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,464	08/01/2001	Udo Heider	MERCK-2295	2894

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EXAMINER

TSANG FOSTER, SUSY N

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,464

Applicant(s)

HEIDER ET AL.

Examiner

Susy N Tsang-Foster

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1745

DETAILED ACTION***Response to Amendment***

1. This Office Action is responsive to the amendment filed on 8/7/2003. Claims 2 and 11 have been cancelled. Claim 1 has been amended.

Art rejections in the previous office based on any one of Chan et al. of record, Pavlenko et al. of record, Jander et al. of record, and Heider et al. (US 6,423,454 B1) are withdrawn in view of applicant's amendment to claim 1.

The double patenting rejection in the previous office action is withdrawn in view of applicant's amendment to claim 1.

Art rejections in the previous office based on any one of Heider et al. (US 2002/0001755 A1), Schmidt et al. (US 2002/0012850 A1) and Schmidt et al. (US 2002/0015884 A1) are maintained because the certified translation of the foreign priority document 10038858.2 filed on August 4, 2000 does not support the limitations that M^{n+} can be $NR^1R^2R^3R^4$, $PR^1R^2R^3R^4$, $P(NR^1R^2)_kR^3_mR^4_{4-k-m}$ (where $k = 1-4$, $m=0-3$ and $k+m \leq 4$), $C(NR^1R^2)(NR^3R^4)(NR^5R^6)$, $C(aryl)_3$, Rb, or tropylium, and that R^1 to R^6 can be alkyl or aryl (C_1-C_8), which are optionally substituted by F, Cl, or Br that are presently recited in independent claim 1. The foreign priority also does not support that M^{n+} can be $P(NR^1R^2)_kR^3_mR^4_{4-k-m}$ (where $k = 1-4$, $m=0-3$ and $k+m \leq 4$), $C(aryl)_3$, Rb, or tropylium, and that R^1 to R^4 can be H. The remaining claims all depend from claim 1. The only overlap between claim 1 and the foreign priority document is that M^{n+} can be $NR^1R^2R^3R^4$, $PR^1R^2R^3R^4$, $C(NR^1R^2)(NR^3R^4)(NR^5R^6)$, and that R^1 to R^6 can be H as seen on page

Art Unit: 1745

2 of the translated foreign priority document. Therefore, the effective date for all the pending claims of this present application is August 1, 2001.

Claims 1, 3-10, and 12-16 are pending and are finally rejected for reasons of record which are reiterated below for applicant's convenience.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-10, and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Heider et al. (US 2002/0001755 A1).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See paragraphs 162-178 and paragraphs 204-227 of the reference.

Art Unit: 1745

4. Claims 1, 3-10, and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt et al. (US 2002/0012850 A1).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See paragraphs 63-77, 106-163, and 190-210 of the reference.

5. Claims 1, 3-10, and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt et al. (US 2002/0015884 A1).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See paragraphs 9-21, 28-44, 109-123, and 152-157 of the reference.

Response to Arguments

6. Applicant's arguments filed 8/7/2003 have been fully considered but they are not persuasive.

It is noted that the translation of the foreign priority document does not support all the limitations recited in instant claim 1 for reasons given above in the response to argument section. The effective date for all the pending claims is August 1, 2001.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1745


Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (703) 305-0588. The examiner can normally be reached on Monday through Thursday from 9:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (703) 308-2383. The phone number for the organization where this application or proceeding is assigned is (703) 305-5900.

The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9310 for regular communications and (703) 872-9311 for After-Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

st/



Susy Tsang-Foster
Primary Examiner
Art Unit 1745